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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/709,131	11/10/2000	Ronald B. Gartenhaus	9598-30U1	4043

570 7590 02/11/2002

AKIN, GUMP, STRAUSS, HAUER & FELD, L.L.P.  
ONE COMMERCE SQUARE  
2005 MARKET STREET, SUITE 2200  
PHILADELPHIA, PA 19103

EXAMINER

UNGAR, SUSAN NMN

ART UNIT PAPER NUMBER

1642

DATE MAILED: 02/11/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/709,131

Applicant(s)

Gartenhaus

Examiner

Ungar

Art Unit

1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE one MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Nov 10, 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-31 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 20) ☐ Other:

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1. Claims 1-31 are pending in the application and are currently under prosecution.

**Please Note:** In an effort to enhance communication with our customers and reduce processing time, Group 1640 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is 703-308-4315. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Anthony Caputa, Ph.D., Supervisory Patent Examiner at 703-308-3995. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

2. Restriction to one of the following inventions is required under 35 U.S.C. § 121:

**Group I.** Claims 1-12,19, 22-23 and 31 are drawn to an isolated nucleic acid molecule classified in Class 536, subclass 23.1.

**Group II.** Claim 13 is drawn to an isolated molecular beacon nucleic acid classified in Class 536, subclass 23.1

**Group III.** Claims 14-17 are drawn to an isolated polypeptide classified in Class 530, subclass 350.

**Group IV.** Claim 18 is drawn to an *in vitro* method of reducing MCT-1 expression classified in Class 435, subclass 6.

**Group V.** Claims 20-21 are drawn to a method of increasing MCT-1 production *in vitro*, classified in Class 435, subclass 6.

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**Group VI.** Claims 20-21 are drawn to a method of increasing MCT-1 production *in vitro*, classified in Class 435, subclass 4.

**Group VII.** Claim 24 is drawn to a method of determining whether a test compound, other than a gene product, is a modulator of MCT-1 expression, classified in Class 436, subclass 63.

**Group VIII.** Claims 25 and 24 as drawn to a method of determining whether a test compound, a nucleic acid a gene product, is a modulator of MCT-1 expression, classified in Class 435, subclass 6.

**Group IX.** Claims 25 and 24 as drawn to a method of determining whether a test compound, a polypeptide gene product, is a modulator of MCT-1 expression, classified in Class 435, subclass 4.

**Group X.** Claims 26-27 are drawn to a method of determining whether a cell is a tumor cell comprising measuring MCT-1 mRNA expression, classified in Class 435, subclass 6.

**Group XI.** Claims 26-27 are drawn to a method of determining whether a cell is a tumor cell comprising measuring MCT-1 protein expression, classified in Class 435, subclass 7.1.

**Group XII.** Claims 28-29 are drawn to a method of determining whether a cell is a tumor cell comprising measuring MCT-1 copy number, classified in Class 435, subclass 6.

**Group XIII.** Claim 30 is drawn to a method of conferring growth advantage to a cell *in vitro*, classified in Class 435, subclass 6.

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3. The inventions are distinct, each from the other because of the following reasons:

Inventions I-III as disclosed are biologically and chemically distinct, unrelated function, made by and used in different methods and are therefore distinct inventions.

Inventions IV-XIII are materially distinct methods which differ at least in objectives, method steps, reagents and/or dosages and/or schedules used, response variables, and criteria for success.

The inventions of Groups I and IV/V/VI/VIII/IX/X/XII/XIII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (I) the process for using the product as claimed can be practiced with another materially different product or (ii) the product as claimed can be used in a materially different process of using that product [see *MPEP* § 806.05(h)]. In the instant case the nucleic acid product as claimed can be used in a materially different process such as a probe for identifying related genes.

The inventions of Groups III and VI/IX/XI/ are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (I) the process for using the product as claimed can be practiced with another materially different product or (ii) the product as claimed can be used in a materially different process of using that product [see *MPEP* § 806.05(h)]. In the instant case the protein product as claimed can be used in a materially different process such as an antigen for producing an antibody to the polypeptide.

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The inventions of Groups II and IV-XIII are not at all related because the product of Group II is not used in any of the methods of Groups IV-XIII.

The inventions of Groups I and VII/XI are not at all related because the product of Group I is not used in any of the methods of Groups VII/XI.

The inventions of Groups III and IV/V/VII/VIII/X/XII//XIII are not at all related because the product of Group III is not used in any of the methods of Groups IV/V/VII/VIII/X/XII//XIII .

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and/or recognized divergent subject matter, restriction for examination purposes as indicated is proper.

5. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Ungar, PhD whose telephone number is (703) 305-2181. The examiner can normally be reached on Monday through Friday from 7:30am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, can be reached at (703) 308-3995. The fax phone number for this Art Unit is (703) 308-4242.

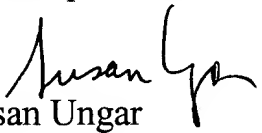
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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Effective, February 7, 1998, the Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1642.

  
Susan Ungar  
Primary Patent Examiner  
February 7, 2002



# RESTRICTION ELECTION FACSIMILE TRANSMISSION

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